Remarks

Reconsideration of the above-identified application in view of the present Amendment is respectfully requested.

Claims 1- 10 are pending in the present application. Claims is rejected under 35 U.S.C. § 102(a). Claims 2-10 are rejected under § 103(a).

Figure 5 is removed from the application. The corresponding text in the Specification is amended to remove any references to Figure 5 and to correct a typo. Moreover, the text is amended to read more clearly without reference to this figure. No new matter is added.

A. Rejection Under 35 U.S.C. § 102

Claims 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over GB 1,444,858 (the '858 patent")

For a claim to be anticipated under § 102, "each and every element of the claimed invention be disclosed in the prior art. . . . In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). The '858 patent cited by the Examiner disclose every element of the claimed invention for the reasons set forth below.

The '858 patent discloses method of making permanent magnets on a surface of paper, cloth, plastics material film or other flexible base material." (the '858 patent, ll. 10-14.) The '858 patent describes the method as:

> Accordingly, in one aspect, the present invention provides a method of manufacturing a film-formed permanent magnet, which method includes; **providing a paste** containing a solvent

> and a mixture of a magnetizable material and a bonding agent, the said mixture containing from 80 to 98% by weight of a finely powdered hard magnetic substance as the magnetizable material; **depositing a thin film-like coating of the paste** on the surface of a thin sheet-like base material; sequentially passing the coating under a plurality of leveling knives arranged in series to level the coating to a uniform thickness and to provide the coating with a smooth surface; magnetizing the finely powdered hard magnetic substance in the leveled coating perpendicular to the surface of the base material; drying the magnetized coating; and roll pressing the dried coating on the base material.
> (the '858 patent, ll. 60-80, emphasis added)

The method disclosed in the '858 patent utilizes a paste of material which is deposited on a thin sheet-like substrate. This is not a kinetic spray process. Claim 1 clearly and unambiguously states that the electric machine of the present invention comprises "a kinetically sprayed permanent magnet material and a binder material forming a composite admixture having microstructures of permanent magnet material embedded in the binder material." Nowhere in the '858 patent is a kinetic spray process mentioned. Accordingly, claim 1 cannot be rejected under § 102 since not every limitation of this claim is disclosed in the '858 patent.

Similarly, the '858 patent standing alone can not be used to support an obviousness rejection under 35 U.S.C. § 103(a). As set forth above, the '858 patent does not disclose a "a kinetically sprayed permanent magnet material and a binder material forming a composite admixture having microstructures of permanent magnet material embedded in the binder material." The Examiner has not offered a reference in this current rejection which discloses such a kinetic spray process. Moreover, the '858 is directed to a method of making permanent magnets on a "surface of paper, cloth, plastics material film or other flexible base material." (the '858 patent, ll. 10-14.) The present invention is directed to electric machines. Again, the '858 patent is void of any mention of electric machine application. Accordingly, claim 1 is patentable over the '858 patent.

B. <u>Rejection Under 35 U.S.C. § 103</u>

Claims 2-10 are rejected under § 103(a) as being unpatentable over the '858 patent.

As set forth above for claim 1, the '858 patent standing alone can not be used to support an obviousness rejection under 35 U.S.C. § 103(a). Claims 2-10 each depend from claim 1 which has as an element "a kinetically sprayed permanent magnet material and a binder material forming a composite admixture having microstructures of permanent magnet material embedded in the binder material." The '858 patent does not disclose such an element. Instead, the '858 patent discloses a method and apparatus for making a magnetic film by a process which uses a "paste containing a solvent and a mixture of a magnetizable material and a bonding agent, the said mixture containing from 80 to 98% by weight of a finely powdered hard magnetic substance as the magnetizable material" which is deposited on a substrate and then smeared out by a "plurality of leveling knives." (the '858 patent, ll. 60-80, emphasis added)

Claims 2-10 are allowable since they are dependent from claim 1 which has now been shown allowable. Moreover, the Examiner states that the '858 patent renders claim 2-10 obvious because in his opinion "the limitations of these dependent claims are conventional and do not render these claims unobvious." (Office Action dated 7/28/03.) However, the Examiner offers no analysis or explanation for this proposition. Again, such a rejection cannot stand because the '858 patent does not disclose a kinetic spray process. Accordingly, the Applicant respectfully requests that claims 2-10 be allowed because the Examiner has failed to set forth a prima facie case of unobviousness.

Conclusion

Applicants have made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If a telephone or video conference would

help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Applicants believe that no additional fees are required as a result of the filing of this paper. However, the Examiner is authorized to charge any additional fees or credits as a result of the filing of this paper to Ford Global Technologies, Inc.'s Deposit Account No. 06-1510 as authorized by the original transmittal letter in this case. If a telephone or video conference would help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Respectfully submitted,

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